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13 JAN 2009

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In re Application of CHOI et al :
U.S. Application No.: 10/593,088 :
PCT Application No.: PCT/KR2005/000036 :
Int. Filing Date: 07 January 2005 : DECISION
Priority Date Claimed: 17 March 2004 :
Attorney Docket No.: 8947-000222/US :
For: ANTI-REFLECTED HIGH EFFICIENCY :
LIGHT EMITTING DIODE DEVICE :
:

This is in response to applicant's "Petition Under 37 CFR § 1.42 - 1.47 for Acceptance of an Application Missing Inventor(s)" filed 10 November 2008.

BACKGROUND

On 07 January 2005, applicant filed international application PCT/KR2005/000036, which claimed priority of an earlier Korea application filed 17 March 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 22 September 2005. The thirty-month period for paying the basic national fee in the United States expired on 17 September 2006.

On 15 September 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 09 April 2008, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 09 September 2008, applicant filed a declaration executed by one of the joint inventors.

On 29 September 2008, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which indicated that declarations executed by the remaining inventors must be submitted.

On 10 November 2008, applicant filed the present petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by the available inventor on his/her own behalf and on behalf of the nonsigning inventors.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

The petition states that joint inventors Pun Jae Choi, Jin Soo Park, Seong Han Kim, and Hyeyon Ryong Cho cannot be located.

Pun Jae Choi

The petition does not sufficiently demonstrate that a bona fide attempt was made to find Choi. Although the petition includes documentary evidence of two unsuccessful attempts to reach Choi by postal mail (see affidavit of Se-Jun Oh, ¶¶1-6), there is no indication of any effort to contact Choi by telephone, by electronic mail, through Choi's employer and co-workers, and by searching directories. Thus, it would not be reasonable to conclude at the present time that Choi cannot be located.

Jin Soo Park

The petition does not sufficiently demonstrate that a bona fide attempt was made to find Park. Although the petition includes documentary evidence of two attempts to reach Park by postal mail (see Oh affidavit, ¶¶7-12), copies of the delivery confirmation receipts have not been provided. If the letters were successfully delivered to Park, it cannot be reasonably asserted that Park cannot be found. Furthermore, there is no indication of any effort to contact Park by telephone, by electronic mail, through Park's employer and co-workers, and by searching directories. Thus, it would not be reasonable to conclude at the present time that Park cannot be located.

Seong Han Kim

The petition does not sufficiently demonstrate that a bona fide attempt was made to find Kim. Although the petition includes documentary evidence of one unsuccessful attempt to reach Kim by postal mail (see Oh affidavit, ¶¶13-15), there is no indication of any effort to contact Kim by telephone, by electronic mail, through Kim's employer and co-workers, and by searching directories. Thus, it would not be reasonable to conclude at the present time that Kim cannot be located.

Hyeon Ryong Cho

The petition does not sufficiently demonstrate that a bona fide attempt was made to find Cho. Although the petition includes documentary evidence of one unsuccessful attempt to reach Cho by postal mail (see Oh affidavit, ¶¶16-18), there is no indication of any effort to contact Cho by telephone, by electronic mail, through Cho's employer and co-workers, and by searching directories. Thus, it would not be reasonable to conclude at the present time that Cho cannot be located.

With regard to item (3) above, applicant is advised that effective 22 November 2004, the fee for a petition under 37 CFR 1.47 increased to \$200.00. Any deficiency in the petition fee will be charged to Deposit Account No. 08-0750 as authorized in the petition.

With regard to item (4) above, the petition states the last known addresses of the nonsigning inventors.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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